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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,719	10/01/2004	Toshihiro Suwa	57796US007	9674
32692 7590 04/15/2010 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1715	
			NOTIFICATION DATE	DELIVERY MODE
			04/15/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/509,719	Applicant(s) SUWA, TOSHIHIRO	
	Examiner William P. Fletcher III	Art Unit 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 6 is/are allowed.
- 6) ☒ Claim(s) 7, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment and remarks filed on 4 September 2009, and the further remarks filed on 20 January 2010, are noted with appreciation.
2. Claims 1-4 and 6-10 remain pending.

Response to Arguments

3. The rejections of claims 1-4, 6, and 8, set forth in the prior Office action, are withdrawn in view of the amendment. Neither the cited prior art nor the reference cited in the obviousness-type double patenting rejection teach or suggest *a (meth)acrylate ester having a group that generates a free radical in the release agent precursor by irradiation with ultraviolet radiation*.
4. Claims 7, 9, and 10, are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. As noted in ¶2 of the Office action mailed 7 May 2009, since the cited prior art shows a release agent containing at least one poly(meth)acrylate ester disclosed in the specification, and having the same storage elastic modulus, contact angle, and wetting tension, as claimed, whether or not a functional group on the poly(meth)acrylate ester actually produces a free-radical upon UV irradiation is irrelevant to the finished structure and the products are the same or similar. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

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different process. Once a product appearing to be substantially identical is found, the burden shifts to Applicant to show an unobvious difference. See MPEP § 2113.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 7, 9, and 10, are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/64805 A2.

A. This reference is applied herein again as in prior Office actions.

B. These claims, as amended, remain unpatentable in view of this reference as explained above.

Allowable Subject Matter

7. Claims 1-4 and 6 are allowed.

8. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: With respect to claims 1-4 and 6, the prior art neither teaches nor suggests *a (meth)acrylate ester having a group that generates a free radical in the release agent precursor by irradiation with ultraviolet radiation*. With respect to claim 8, the prior art neither teaches nor suggests the claimed precursor including benzophenone.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. US 4,111,769 A; US 4,165,266 A; and US 5,954,907 A; all teach PSA precursor compositions including benzophenone derivatives as free-radical initiators, but neither teach nor suggest *a (meth)acrylate ester having a group that generates a free radical in the release agent precursor by irradiation with ultraviolet radiation.*

B. US 4,737,559 A teaches a PSA precursor composition including a benzophenone-bearing monomer, but the monomer is not a (meth)acrylate ester.

C. US 3,998,997 A teaches a PSA precursor composition including a benzophenone-bearing (meth)acrylate ester, but the composition is not UV irradiated.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner, Art Unit 1715

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11 April 2010